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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,272	12/09/2003	Laval Chan Chun Kong	VIRO-5	2563

23599 7590 03/14/2007  
MILLEN, WHITE, ZELANO & BRANIGAN, P.C.  
2200 CLARENDON BLVD.  
SUITE 1400  
ARLINGTON, VA 22201 .

EXAMINER
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CHANG, CELIA C

ART UNIT	PAPER NUMBER
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1625

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/14/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.



### DETAILED ACTION

1. Amendment and response filed by applicants dated Dec. 22, 2006 have been entered and considered carefully.

Claims 1-24, 27-32, 3436-37, 43-44, 48-49, 98 have been canceled. Claims 25-26, 33, 35, 38-42, 45-47, 50-97, 99-101 and newly added 102-103 are pending.

2. The rejection of claims 25-26, 35, 42, 45-47, 50, 52-56, 58-59, 64-67 under 35 USC 102(e) over US 6,881,741 is dropped in view of applicants argument that the genus of US 6,881,741 is large thus picking and choosing must be conducted among many options, thus, does not constitute small genus without judicial picking and choosing.

3. The rejection of claims 25-26, 33, 35, 38-42, 45-47, 50-101 over Chan Chun Kong et al. Us 6,881,741 is maintained for claims 25-26, 33, 35, 38-42, 45-47, 50-53, 58-59 and 99 for reason of record.

Applicants argued that choosing among the compounds of the Chan Chun Kong et al. '741 reference is without guidance thus cannot render the instant claims obvious. This is not persuasive because explicit guidance were found in the particular species as pointed out in the previous office action. The difference between claims 25-26, 33, 35, 38-42, 45-47, 50-53, 58-59, and compound 579 at co. 369-370 is that the exemplified compound 579 has the instant Z moiety being cyclohexyl while the instant claims require a methyl substitution on the cyclohexyl; the difference between the claim 99 and compound 573 is that the exemplified compound 573 has a methyl substitution while the instant claim require an ethylpiperidine. Not only one methyl addition to a proven compound is prima facie structural obvious (see In re Wood 199 USPQ 137), such modification is also guided by the reference wherein addition of a methyl group (compound 574 vs 573) is explicitly guided to be an optional choice.

Therefore, contrary to attorney's argument, clear guidance have been provided with structurally close compounds, thus, rendered the instant claims prima facie since the instant claims are narrower based on the particular guidance of the exemplified species but fully

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embraced by the prior art genus. In absence of unexpected results, there is nothing unobvious in picking some among many. In re Lemin 141 USPQ 814.

4. The rejection of claims 25-26, 33, 35, 38-42, 45-47, 50-101 on the ground of nonstatutory obviousness-type double patenting over US 6,881,741 is maintained for claims 25-26, 33, 35, 38-42, 45-47, 50-53, 58-59 and 99.

Applicants argued that the obviousness type double patenting must be evaluated between claims of the instant and the issued patent. Please note that the instant claims are narrow but fully embraced by the issued claims. Please note that the instant claims are drawn to compounds of the issued claims wherein X is NR<sub>3</sub>(MR<sub>2</sub>), M is CO, R<sub>2</sub> is alkyl (cyclohexyl optionally substituted), Y' is bond, Y is COOR, R<sub>3</sub> is alkyl/heterocycle (cyclohexyl/piperidine optionally substituted), Z is H, R<sub>1</sub> is optionally substituted aryl, arylalkyl. Thus, the instant claims are fully embraced narrower scope of the issued claims. In absent of unexpected results, there is nothing unobvious in choosing some among many. 141 USPQ 814.

5. The rejections of claims 40-41, 61-63 under 35 USC 112 first paragraph for lacking sufficient description or lacking sufficient enablement are maintained for reason of record.

The basis for finding the specification insufficient of description has been clearly delineated employing industry standard as seen on page 8 of the previous office action. Applicants argument that one skilled in the art is 'aware of classes of agents does not offer any support for the lacking of description. Broad class of agents have drastically different properties. One may be aware of the class of anti-bacterial but without any description as to which anti-bacterial (please note microbial antibiotics, sulfur drug, etc. have tremendous differences in properties), the specification offered insufficient description as to support the scope of the claims.

The basis for finding the specification insufficient of enablement was the clearly delineated Wands' analysis. Therefore, it is not *mere* assertion but based on item-by-item analysis of the claims and the state of the art with references made available to applicants. In view of the high unpredictability of the pharmaceutical art, applicants offered no factual evidence that how can the undue experimentation well recognized in the art be obviated in

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absence of dosage, sequence, site of which combination under what physiological conditions of the host.

6. The rejection of claims 25-26, 33, 35, 38-42, 45-47, 50-66 under 35 USC 112 second paragraph is dropped in view of the amendment of the claims.

However, claim 100 is rejected under 35 USC 112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what is the first compound in the claim. Is it a salt or an ion? Please note that there is no counter ion. Clarification is required.

7. Claims 51, 54-57, 60-98, 101-103 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang whose telephone number is 571-272-0679. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas McKenzie, Ph. D., can be reached on 571-272-0670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OACS/Chang  
Mar. 6, 2007

  
Celia Chang  
Primary Examiner  
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